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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,302	08/17/2001	Hennie Wesseling	BO44440ACW/S	6564

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EXAMINER

LABAZE, EDWYN

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/856,302

Applicant(s)

WESSELING ET AL. 

Examiner

EDWYN LABAZE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08/17/2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1--27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Receipt is acknowledged of the preliminary amendment filed on 8/17/2001

#### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Claim Objections***

2. Claims 2-9, drawn to the system claims 11-24 are objected to because of the following informalities:

Re claims 2-9, and 11-21: The language "A method or system according to claim ..." for a dependent claim is not acceptable and should be replaced by "The method or system according to claim...".

Re claims 23 and 24: The claim recites "Means for a device that is arranged for" ... is not properly formulated and should be replaced with "A device including a means for arranging" ...

Re claim 22: The word "voor" in claim 22, line 8 is deemed by the examiner as "for".

Appropriate clarification and correction are required.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

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(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-9 drawn to the method, and system/devices claims 10-11, 13-16, 19-21, 23-25, and 27 are rejected under 35 U.S.C. 102(e) as being unpatented by Takai et al. (U.S. 6,024,287). ~

5. Re claim 1: Takai et al. discloses a card-recording medium, certifying method and apparatus for the recording medium, which includes the following steps

(a) making available a unique bit string (col.9, lines 56-63);

(b) establishing an identification code (col.9, lines 64-67, col.16, lines 26-31 and col.19, lines 54-61);

(c) securely printing the franking/true mark on the document/card, said franking mark at least comprising information relating to the bit string and the identification code (col.10, lines 15-34); characterized in that the bit string is selected from a centrally stored of unique bit strings and that the unique bit strings which are made available for use are centrally registered (col.9, lines 40+).

Re claims 2 and 11: Takai et al. teaches a method, characterized in that, prior to step c, the unique bit string and the identification code, protected with the aid of a first message authentication code and/or protected by encoding, are stored by a terminal on an information carrier with memory, and step c takes place after the reading of the information carrier by a printing device (col.11, lines 12-59).

Re claims 3 and 13: Takai et al. discloses a method, characterized in that, besides the unique bit string and the identification code, a terminal identification code, protected with the aid of the first message authentication code and/or by the encoding, is also stored on the information carrier with memory by the terminal (col.11, lines 64-67 and col.12, lines 1-23).

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Re claims 4 and 14: Takai et al. teaches a method, characterized in that after reading of the information carrier by the printing device, use of the unique bit string for printing a further franking mark on a further document is rendered impossible by the printing device (col.5, lines 53-67).

Re claims 5, 15, and 24: Takai et al. discloses a method, characterized in that, after reading the information carrier, it is checked whether the value of a counter on the information carrier lies within predefined limits, and, if this is the case, the value of the counter is adjusted after reading and step c is executed, and, if it is not step c is blocked (col.18, lines 3-47).

Re claims 6 and 16: Takai et al. teaches a method, characterized in that, upon execution of step c, use is made of a computer (col.6, lines 48-50; col.9, lines 25-30, and col.24, lines 61-67) and a printing device 840 (col.17, line 47) connected thereto.

Re claims 7 and 19: Takai et al. discloses a method, characterized in that the identification code comprises a user identification code and/or a printer identification code (col.15, lines 21-24).

Re claims 8 and 20: Takai et al. teaches a method, characterized in that on the basis of the franking mark a second message authentication code is calculated and that this also is printed and/or the franking mark is printed in encoded form (col.6, lines 1-42).

Re claims 9 and 21: Takai et al. discloses a method, characterized in that the set of unique bit string is stored in a first central memory, used combinations of identification codes and unique bit string are stored in a second central memory, franking marks printed on documents are read in, combinations of identification codes and unique bit strings which are present in the read-in franking marks are stored in a third central memory and are compared to the combinations in

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the second memory (col.8, lines 56-67; col.9, lines 1-24; col.9, lines 53-67; col.10, lines 1-10 and col.10, lines 63-67+).

Re claim 10: Takai et al. teaches a system, which includes means for making available a unique bit string (col.8, lines 39-41); means 33 for establishing an identification code (col.13, lines 16+); means 35 for securely printing the franking mark at least comprises information relating to the bit string and the identification code (col.13, lines 60+); characterized in that the means for making available a unique bit string comprise a first centrally arranged memory with a set of unique bit strings, from which the unique is selected, and that means are provided for centrally registering which unique bit strings have been made available for use (col.12, lines 37-56).

Re claim 23: Takai et al. discloses a system, which includes means for a device/computer that is arranged for printing a franking mark on a document, said means at least being arranged for receiving data from an information carrier/credit card 25 (col.8, lines 11+), said data at least comprising a unique bit string originating from a set of unique bits strings (col.10, lines 1+), for compiling and marking data available for the franking mark for the document in protected form (col.13, lines 17+), so that said device can print the franking mark on the document securely (col.15, lines 59+), said franking mark at least comprising the said data as well as an identification code (col.19, lines 54-61).

Re claim 25: Takai et al. teaches a system, which includes an information carrier 25 (col.8, lines 11+), provided with a memory which at least contains the following data: a unique bit string, selected from a set of unique bit strings (col.9, lines 64+ and col.10, lines 1+), an identification code and a message authentication code which is calculated on the basis of at least

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the unique bit string and the identification code and/or unique bit string and the identification code in encoded form (col.16, lines 26-67+).

Re claim 27: Takai et al. discloses a system, which includes data carrier wave or card 220 (col.17, line 47) provided with software for downloading to a computer, which, after being read, enables the computer to execute a method for printing a franking mark on a document (col.17, lines 49+) comprises the following steps: the reception of unique bit string (col.9, lines 56-63); establishing an identification code (col.9, lines 64-67, col.16, lines 26-31 and col.19, lines 54-61); securely printing the franking mark on the document, said franking mark at least comprising information relating to the bit string and the identification code (col.10, lines 15-34); where the bit string is received from a centrally stored set of unique bit strings (col.9, lines 19-30).

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 12, 17, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takai et al. (U.S. 6,024,287) in view of Kubatzki et al. (U.S. 6,064,994).

The teachings of Takai et al. have been discussed above.

Takai et al. fails to disclose an exchange, which comprises of central memories and central input means for inputting franking marks on documents.

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Kubatzki et al. teaches a method and arrangement for data processing in a mail-shipping system, which includes a write/read unit comprises of a data exchange between the unprotected and/or the protected card memory (col.16, lines 1-13), and input means (col.13, lines 34-40; col.19, lines 33-42).

In view of Kubatzki et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a data exchange as to store the information in the memories for fraude detection at a later stage, protect the authenticity of franking mark/document after verification. The data exchange inhibits functions for unauthorized users. The data exchange is also deemed as a storage and a comparator, as mentioned by Takai et al. (col.8, line13), to compare, produce and issue franking marks/numbers, such the bit strings and/or identification code, stored in the memory with the franking numbers read from the terminal. Moreover, such modification would have been an obvious extension of as taught by Takai et al.

8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takai et al. (U.S. 6,024,287) in view of Peyret (U.S. 5,688,056).

The teachings of Takai et al. have been discussed above.

Takai et al. fails to disclose a computer-readable, provided with software, which enables the computer execute a method for printing franking mark on a document.

Peyret teaches a method for controlling a printer in order to print legitimate postal marks, which includes a computer-readable information carrier, provided with software, which enables the computer to execute a method for printing franking mark on a document (col.4, lines 58-67 and col.5, lines 1-67).



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In view of Peyret's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the computer-readable information carrier or a compact disc with the software programming to the teachings of Tahai et al. in order to install/run a program enabling the processor to verify authentication, inhibit further operations of the machine when detecting forged document, validate legitimacy of printing of legal or frank marks, and deter fraudulent document/marks. The computer-readable information carrier may contain data or information to be loaded on the CPU for verification of the franking marks. Furthermore, such modification would have been an obvious extension of the teaching of Takai et al., and therefore an obvious expedient.

*Additional Remarks*

9. It has been noted by the examiner that U.S. Patent No. 5,838,812 reference was cited as "x" in the PCT/EP99/09170 dated 15 February 2000.

*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dymetman et al. (U.S. 6,330,976) discloses a marking medium area with encoded identifier.

Cass et al. (U.S. 6,141,441) teaches a technique for decoding message that has been encoded into a printed color image.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (703) 305-5437.

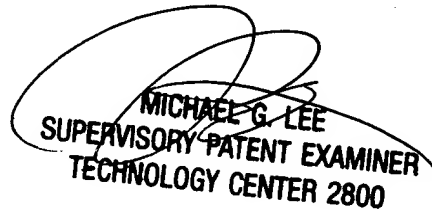
The examiner can normally be reached on 7:30 AM - 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

el  
Edwyn Labaze  
Patent Examiner  
Art Unit 2876  
October 17, 2002

  
MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
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